

### **REMARKS/ARGUMENTS**

Before this Amendment, claims 1-15, 18-20, 23, and 24 were examined. Claim 25 was added, while no claims are canceled. Claims 1, 18, 23, are amended, and support for the amendments can be found in the Specification (Original Application, p. 13, ll. 14-18, 25-26; p. 14, ll. 15-32; p. 16, ll. 9-16, 19). Therefore, claims 1-15, 18-20, and 23-25 are present for examination, and claims 1, 18, 23, and 25 are the independent claims.

Claims 1-7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the cited portions of U.S. Pat. No. 6,614,987 ("Ismail") in view of the cited portions of U.S. Patent No. 5,619,247 ("Russo"). Claims 18-19 and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ismail in view of Russo and further in view of the cited portions of U.S. Patent No. 5,790,935 ("Payton"). The remaining claims stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ismail in view of Russo and further in view of additional cited art. Claims 1, 18 and 23 stand rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement.

A Request for Continued Examination is filed concurrently herewith. Thus, reconsideration is respectfully requested in light of the amendments. Applicants respectfully request that the rejection be reconsidered and withdrawn in light of the claim amendments and discussion below.

#### **35 U.S.C. §103 Rejection, Ismail, Russo, Payton**

The Office Action rejected independent claim 1 under 35 U.S.C. §103(a) as unpatentable over Ismail in view of Russo. The Office Action rejected independent claims 18 and 23 under 35 U.S.C. §103(a) as being unpatentable over Ismail in view of Russo and Payton. To establish a *prima facie* case of obviousness, the prior art references must "teach or suggest all the claim limitations." MPEP § 2143. The Applicants assert that significant limitations from the amended independent claims are neither taught nor suggested in the references.

The Examiner is respectfully asked to refer to related Application No. 09/687, 148, a commonly assigned application from the same inventors. The Specification from that Application was, in fact, incorporated into the present application. The Examiner is also asked to refer to his Action in that case dated July 11, 2006, and note the similarities between the present amendments and the allowable material from the related case.

Ismail, Russo: Regarding claim 1, the cited references simply cannot be relied upon to teach or suggest 1) identifying when a user has tuned to a program having a counterpart on a server or 2) transmitting a signal causing a notification symbol to be superimposed on a broadcast program to distinguish it from other broadcast programs without counterparts on the server.

Ismail instead sets forth a system of television program recording with user preference determination. However, the programs are recorded for *subsequent* viewing. There is thus no identification of when a user has tuned to a program having a substantially identical counterpart on a server. Russo teaches a preloaded pay per play system, with playback of the movies from the headend, which clearly differs from the claims as well.

Clearly, neither Ismail or Russo suggest identifying when a user has *tuned* to a program having a counterpart on a server. Moreover, it follows that there is similarly no suggestion of a notification symbol superimposed on a broadcast program to distinguish it from other broadcast programs without counterparts on the server.

Ismail, Russo, Payton: Regarding claim 18, neither Ismail, Russo, or Payton can be relied upon to teach 1) detecting a request from the user for program control over a particular broadcast program, or 2) transmitting a signal causing a notification symbol to be superimposed on a broadcast program to distinguish it from other broadcast programs without counterparts on the server.

As noted above, Ismail instead sets forth a system of television program recording for *subsequent* viewing. There is thus no detection of a request for program control of a program transmitted according to a schedule of programming, nor is there a

suggestion that the system be configured with such ability. Moreover, Russo's pay per play system from the headend falls far short of suggesting a transmitted notification symbol superimposed on a broadcast program to distinguish it from other broadcast programs without counterparts on the server. Stored program pay for play clearly differs from program control over scheduled programming.

Payton describes an on demand delivery system which polls both local storage and a central distribution mechanism. However, there is again no suggestion of identified elements. The amendments above clearly differentiate claim 18 from the cited art.

Independent claims 23 and 25 contain similar limitations, providing for identification and notification steps, and allowing the user to switch from transmission of the particular program according to the schedule of programming to transmission of a substantially identical counterpart program from the server, wherein program control of the counterpart is from the temporal position of the scheduled programming. For the reasons noted above, neither Ismail, Russo or Payton can be relied upon to teach these limitations.

Because it is asserted that the cited references do not teach the limitations at issue, it is respectfully submitted that independent claims 1, 18, 23, and 25 are allowable. Claims 2-15, 19-20, and 24 each depend from the independent claims, and these claims are believed allowable for at least the same reasons as given above. Applicants, therefore, respectfully request that the rejections under 35 U.S.C. 103(a) be withdrawn.

### **35 U.S.C. §112 Rejection**

Claims 1, 18 and 23 stand rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement. The claims are amended to address the issues raised by the Examiner.

### **CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

Appl. No. 09/687,149  
Amdt. dated October 27, 2006  
Amendment under 37 CFR 1.116 Expedited Procedure  
Examining Group 2623

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



Michael L. Drapkin  
Reg. No. 58,696

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 303-571-4000  
Fax: 415-576-0300  
MLD:klb  
60861809 v1